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D E C I S I O N
of 30 August 2000

Case Number: T 0092/98 - 3.3.4

Application Number: 91301121.9

Publication Number: 0443763

IPC: A23C 11/00

Language of the proceedings: EN

Title of invention:

Formulated milk for infants analogous to human milk

Patentee:

MEIJI MILK PRODUCTS COMPANY LIMITED

Opponents:

Société des Produits Nestlé S.A., Vevey
Stichting Behartiging Octrooibelangen

Headword:

Formulated milk/MEIJI

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendments - allowable"

Decisions cited:

-

Catchword:

-



Case Number: T 0092/98 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 30 August 2000

Appellant: MEIJI MILK PRODUCTS COMPANY LIMITED
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Respondent I: Société des Produits Nestlé S.A., Vevey
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Respondent II: Stichting Behartiging Octrooibelangen
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 23 October 1997
revoking European patent No. 0 443 763 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: D. D. Harkness
W. Moser

Summary of Facts and Submissions

I. European patent No. 0 443 763 having the title "Formulated milk for infants analogous to human milk" was opposed by respondents I and II (opponents 01 and 02) for lack of novelty, inventive step and insufficient disclosure, and this appeal lies from the decision of the opposition division to revoke the patent for lack of compliance of an amended set of claims with Article 123(2) EPC. The issues of novelty, inventive step and insufficiency were not considered in the decision.

II. Claim 1 of the European patent application as filed read as follows:

"1. A formulated milk composition for infants analogous to human milk which comprises adding a composition containing non-protein nitrogen components obtained by treating whey."

Claim 1 of the granted patent read as follows:

"1. A method for producing a formulated milk composition for infants and analogous to human milk, which comprises, mixing together materials known to be suitable for use in a formulated milk composition for infants and, as a material to increase the content of non-protein nitrogen in said formulated milk composition to 60% or more of non-protein nitrogen in human milk, a product containing non-protein nitrogen components which is obtained by treating whey."

III. The appellant (proprietor of the patent) lodged an appeal and filed a new main request and five new

auxiliary requests. The Board communicated a provisional opinion to the parties after which the appellant provided a new set of requests. Previous "Auxiliary request 2" was made the new main request. Respondent II withdrew his request for oral proceedings. Respondent I did not request oral proceedings in case that the only issue in oral proceedings would be the question of allowability of the claims of the newly filed requests under Article 123 EPC and that the Board would remit the case under Article 111(1) EPC for further prosecution i.e. examining the issues under Articles 52(1), 54, 56 and 83 EPC.

IV. Claim 1 of the new main request (former auxiliary request 2) reads as follows:

"1. A method for producing a formulated milk composition for infants and analogous to human milk, which comprises, mixing together materials known to be suitable for use in a formulated milk composition for infants and, as a material to increase the content of non-protein nitrogen in said formulated milk composition to 60% or more of non-protein nitrogen in human milk, a product containing non-protein nitrogen components which is obtained by treatment comprising subjecting whey to ultrafiltration, concentrating a permeate obtained by ultrafiltration, and subjecting the concentrated permeate to lactose-crystallizing followed by lactose-removing."

V. The appellant's submissions are summarised as follows:

The manner of "treating whey" to effect recovery of the non-protein nitrogen components (NPN) from whey had

been particularised by the limitation of the claim as follows: "subjecting whey to ultrafiltration". That treatment yields a permeate which still included lactose as well as the target NPN components in some considerable dilution. Concentrating the permeate was a necessary step required to recover the NPN in desirable concentrations, and lactose was taken out by subjecting the concentrated permeate to lactose-crystallizing followed by lactose removing.

Lactose was an undesirable component and could be removed according to known conventional methods which included crystallizing or seeding of lactose, and the thus formed lactose precipitate could be discarded either by filtration or by decanting off the overhead target NPN containing liquor. Those skilled in the art would understand that in the patent in suit the term "lactose removing" had the same technical objective or effect as the term "lactose separating" and, therefore, to a skilled person these terms were synonymous. Further, due to the context in the description of the patent in suit and due to the inclusion of the term "lactose-crystallizing" before the term "lactose-removing" in claim 1 of the main request, a person skilled in the art would understand that removal/separation of the crystals was necessary, and he or she would be well aware of how to achieve the same by way of conventional methods.

VI. The submissions by the respondents can be summarised as follows:

The European patent application only disclosed methods of lactose removal after crystallisation by filtration or decantation of the liquid from the formed

precipitate (based on page 10, line 5 and respectively on page 12, lines 7 to 8 of the description as filed). The skilled technician would understand by "removal by decantation" in Example 1, that after the formation by physical separation of a solid phase at the bottom and a liquid phase at the top in a refrigerator, the solid phase was separated from the liquid phase by filtration. There was no other possible meaning compatible with the indication in the general description, by definition broader than in the Example, of "separation by filtration".

The general statement "treating whey" in claim 1 of the application as filed was so broad as to be essentially meaningless and thus could not serve as a basis for introducing the generic meaning "removal" in the claims which is not based on the description. Particularly, it was not evident to the skilled person that the meaning of the specific feature "filtration" was generally applicable to "removal", so that generalisation could not be allowed in the present case. In particular, the wording "removing" would be synonymous with "separating", and "lactose removing" (or rather "lactose separation") as disclosed in the application as filed had always been related to "crystallising" and "decantation".

Japanese Patent Publication 60-54637 disclosed only a two-times concentration - lactose crystallisation - separation step. The same publication, moreover, taught that this separation step leads only to a separation of 91 to 98% of the lactose initially contained (ie not a "removal").

VII. The appellant requested that the decision under appeal

be set aside, that the claims of the main request (claims 1 to 4 of the former auxiliary request 2) or of any of the auxiliary requests be declared allowable under Article 123 EPC and that the case be remitted to the first instance for further prosecution.

The respondents requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. The only question to be answered is whether or not the subject-matter of the main or any one of the auxiliary requests complies with Article 123 EPC.

Main request

Article 123(2) EPC

3. Claim 1 specifies the steps of "lactose crystallizing followed by lactose removing", replacing the general term "obtained by treating whey".

It is necessary to determine whether the claims and the description of the application as filed provide a disclosure which makes the claim allowable under Article 123(2) EPC.

4. The two methods described on pages 10 and 12 of the application as filed cause crystals to be formed, and in this event the skilled person would understand the further disclosure to mean the separation/removal of lactose crystals. Since, in this case, the separation

or removal **follows** crystallization, then separation and removal mean the same thing ie, the taking away of the crystals, thus these terms are synonymous.

5. The application as filed at page 10, paragraph 1 makes reference to the disclosure of JP 60-54637 which may be considered to form part of the description of the patent in suit, and this describes the production of a non-protein nitrogen compound containing composition from whey, which process (see page 3, paragraph 3 of the Japanese document) includes the removal of various unwanted components including lactose.

6. The disclosure at page 10, line 5 of the application as filed mentions the separation of crystals by filtration, but the content of the text at page 12, paragraph 2 is not limited to decantation of liquid from the crystals because, after the references to seeding and crystallization of lactose, there comes a full-stop. At this point the skilled person would know that removal/separation of crystals is necessary and would know how to do it. The generality "obtained by treating whey" of claim 1 of the application as filed would allow the consideration of known process steps conventionally employed in a process for treatment of whey which involves standard removing/separating methods for crystals. There is nothing to suggest that the technical contribution to the process would be different if conventionally known separation methods other than filtration or decantation were used, and the Board sees no ground for asserting that there would be. The phrase "lactose removing" in itself does not identify any specific technique for crystal removal not already mentioned in the application as filed and, since the concept of crystal removal was established at

the date of filing (see the European patent application at page 10 paragraph 1 and page 12 paragraph 2), this amendment to the claim does not involve the addition of subject-matter.

7. For these reasons the amendments "crystallizing followed by lactose removal" is allowable under Article 123(2) EPC.
8. There are no objections which can be raised under Article 123(2) EPC against any of the dependent claims 2 and 3. Claim 4 is worded as product-by-process claim and by this incorporates the process of claim 1. This being allowable under Article 123(2) EPC renders also allowable claim 4 under this Article.
9. The main request therefore meets the requirements of Article 123(2) EPC.

Auxiliary requests

10. Since the main request meets the requirements of Article 123(2) EPC there is no need to consider the subsequent auxiliary requests,

Article 111(1) EPC

11. The opposition division did not consider allowability of any claims under Articles 54, 56 and 83 EPC and therefore the case is remitted to the first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

Chairwoman:

M. Kiehl

U. Kinkeldey